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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,087	03/07/2000	Valerie Anne Scott	SG 99428	1098

7590

09/16/2002

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EXAMINER

GUADALUPE, YARITZA

ART UNIT PAPER NUMBER

2859

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,087

Applicant(s)

SCOTT ET AL.

Examiner

Yaritza Guadalupe

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

In response to Amendment filed June 28, 2002.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15 - 21 are finally rejected under 35 U.S.C. 102 (b) as being anticipated by Toole (US 5,179,235).

Toole discloses an optical sighting device comprising an elongated tube / housing (52) having a proximal end and defining a light channel, a lens (54, 56) located at one end of the light channel and having a partially reflective surface (inherently disclosed in order to emit a beam of light), a light source / laser diode (222, 240, 248) located in said tube for emitting light toward said reflective surface to produce a light spot by direct imaging of the laser diode on said reflecting surface and wherein the light spot is being superimposed on a target when sighting through the light the light channel (See Column 6, lines 20 – 28), a battery (202) for providing electric current, and an energizing circuit (74) for energizing the laser diode.

Toole also discloses a control means provided for energizing the laser diode when a weapon (12) to which said optical sight is mounted is to be used and for automatically reducing energization of the laser diode in dependence of a predetermined condition and for adjusting the intensity of the light spot and a pulse width modulation of the laser diode source (See Column 5, lines 28 – 41). Toole discloses a manually operated switch (204) for energizing the laser diode. Toole discloses a control means that is considered to include a time – out circuit for deenergizing since clearly states that as the laser diode output will depend on the current which will be regulate with the driving circuit (See Column 5, lines 28 – 45).

3. Claims 15 – 21 are finally rejected under 35 U.S.C. 102 (b) as being anticipated by Moore (US 5,531,040).

Moore discloses an optical sighting device comprising an elongated tube (32) having a proximal end and defining a light channel, a lens (113) located at one end of the light channel and having a partially reflective surface (inherently disclosed in order to emit a beam of light), a light source / laser diode (112) located in said tube for emitting light toward said reflective surface to produce a light spot by direct imaging of the laser diode on said reflecting surface and wherein the light spot is being superimposed on a target when sighting through the light the light channel, a battery (58) for providing electric current, and an energizing circuit (110) for energizing the laser diode.

Moore also discloses a control means provided for energizing the laser diode when a weapon to which said optical sight is mounted is to be used and for automatically reducing energization of the laser diode in dependence of a predetermined condition and for adjusting the intensity of the light spot and a pulse width modulation of the laser diode source (See Columns 6 - 7, lines 39 - 67 and 1 - 66 respectively). Moore discloses a manually operated switch (122, 124, 130) for energizing the laser diode. Moore discloses a control means that is considered to include a time - out circuit for deenergizing since clearly states that as the laser diode output will depend on the current which will be regulate with the driving circuit (See Column 6, lines 55 - 67). Moore discloses a pulsing circuit which in a broad sense is operable to generate pulses of electric current at a rate such that that the pulsing of the laser light is not apparent to the user.

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 4 - 14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant arguments regarding the Toole reference has been considered. The Examiner would like to clarify and points out that the invention was totally understood from the beginning, however, when a rejection is made, the rejection is based on the claimed subject matter and Toole clearly teaches what was claimed by Applicant, which failed to provide limitation on the particular type of optical sight intended to be claimed.

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Furthermore, Applicant is reminded that an "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphases in original). To emphasize the point further, the court added: "An invention need not operate differently than the prior art to be patentable, but need only be different" (emphases in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention.

With respect to Applicant arguments regarding the energizing circuit for energizing the laser diode and operable to apply a pulsating electric current from said battery to said laser diode source, the way an energizing circuit is operable is only considered a functional limitation that is given enough patentable weight since any energizing circuit has to be operable so as to apply the correspondent energy, i.e., DC or pulse electric current, to which was created to energize. However, in view of Applicant remarks, the Examiner is now using Moore in order to fully fulfill the requirements of the claimed subject matter.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9318 for regular communications and (703)872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Yaritza Guadalupe
Patent Examiner
Art Unit 2859
September 14, 2002

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